

REMARKS

Claims 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189, 190, 194, 195, 197, 200-202, 204-206, 209, and 210 presently stand rejected. The scope of Claims 1-2, 4-10, 12, 14-15, 19-26, 28-29, 32, 36-37, 39, 45-49, 51-52, 54-57, 59-60, 62-65, 67-68, 71-73, 75, 77-78, 82-93, 95-96, 98-105, 108-111, 114-115, 117-120, 123-, 125-128, 131-142, 144-152, 155-156, 159, 164-165, 169-170, 179-180, 182, 185-186, 190, 194, 205-206, and 209 are amended. Claims 53, 70, 97, 116, 143, 160-163, 167, 171-178, 181, 183-184, 188, 191-193, 196, 198-204, 207-208, and 211 are canceled, without prejudice.

Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them based on the reasons demonstrated here.

Relevant Prosecution History

The present claims are rejected based solely on U.S. Patent No. 5,655,085 issued to Ryan et al. ("Ryan '085"). Ryan '085 is a continuation-in-part of U.S. Patent No. 5,673,402 issued to Ryan et al. ("Ryan '042"). The different subject matter in Ryan '085 is directed to "illustrations of insurance" that can be produced rather than "illustrations of collateral used to repay a mortgage," which was disclosed in Ryan '402. Other than that difference, the methods and systems described in both the Ryan patents ('085 and '042) are substantially similar, if not identical. During prosecution of Applicant's parent U.S. Patent No. 5,987,434, Ryan '402 was the only reference asserted to reject the claims. Applicant demonstrated the differences between Ryan '402 and the claims in the application of the '434 patent, which resulted in issuance of the '434 patent. Since issuance, U.S. Patent No. 5,987,434 has undergone two separate re-examination proceedings, the most recent confirming all claims as issued (Control Nos. 90/007,498 & 90/008900).

The present application is a continuation-in-part of U.S. Patent 5,987,434. Applicant demonstrates here the reasons by which the present, rejected claims are also distinct from Ryan '085, for reasons that are largely similar to those urged previously to overcome Ryan '402 during prosecution of U.S. Patent 5,987,434.

35 U.S.C. § 102 Rejections

Claims 1-11, 53-73, 116-131, 139-141, 143-159, 164-169, 179, 182, 185-187, 189-190, 194-195, 197, 200-202, 204-206, 209-210 presently stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ryan '085. Applicant respectfully traverses this rejection.

Ryan '085 does not teach each and every element of the amended claims. First, Ryan '085 does not disclose the step of “automatically inputting into one or more of the associated databases, a plurality of client records without human intervention between input of the respective client records, the client records comprising client data on specific entities.” The Examiner states

Applicant argues that Ryan doesn't teach producing high volume offer in an automated manner. The Examiner disagrees with Applicant because Ryan teaches automating the process of delivering financial products such as insurance policies to users based on the user's personal information. Advisory Action (10/31/08), p. 2.

Applicant does not understand the Examiner's reasoning here that because “Ryan teaches automating the process...based on the user's personal information,” Ryan therefore, anticipates, or even is applicable to, the present claims that clearly claim an automated process for achieving a high volume of offers for multiple clients. Ryan's method is strictly a method that can only process universal life insurance policy illustrations **one at a time**. Applicant has amended the claims to more particularly emphasize the differences between Ryan and the present claims.

Furthermore, Ryan discloses a method wherein a computerized system assists in illustrating a life insurance policy and then electronically completing an application form. This method is still firmly rooted in the one-on-one selling paradigm of insurance policies, where an insurance agent sits down with a client and conducts an interview to gather the information needed or manually inputs information provided to the agent in a questionnaire. Ryan removes the need for the insurance agent “to go to many different insurance companies to request quotes...[and] conduct lengthy and time-consuming analyses to establish which was the best product for the customer.” Ryan '085, col. 2, lines 17-23. Most certainly, Ryan does not disclose the decision-making ability to determine a financial product or service, select the appropriate data to market the product, and then produce an offer for that product as claimed.

Second, Ryan does not disclose “using said processor to consider the client data on the specific entities and financial product data relating to the one or more financial products or

financial services and determine whether to offer a financial product or a financial service or both to the specific entities.” The Examiner states

although in Ryan, the information about the user can be manually inputted into the system, Ryan uses a computer processor to consider the inputted data (Figure 7) in order to determine if based on the client data, the user should be offered a particular financial product/life insurance policy. The computer processor in Ryan, calculates an insurance policy for the client/user based on the information about the user/client. Applicant argues that in Ryan a determination has already been made whether to offer a product to a user. The Examiner disagrees with Applicant because in Ryan the information about the user is used to determine whether or not to offer a particular insurance product to the user therefore the determination is not pre-made because the computer processor first has to receive the information about the user in order to determine if any product should be offered to that particular user. Advisory Action (10/31/08), p. 2.

Once a user (i.e., an agent) has decided to utilize Ryan’s system, the determination of the product type has already been made—universal life insurance—by a **human**. If a human has not made this determination, then universal life insurance is not the product chosen, and Ryan’s system and method are of no use. The fact that Ryan uses a processor to compare different universal life insurance parameters does not change the fact that a human, and not a processor as claimed, has made the determination that a product will be offered.

In fact, Ryan requires a user to specify everything about the product except the premium, for example, the policy type (individual or joint & survivor), the minimum death benefit, the cash value and year attained, the yearly payment, the waiver of premium annual benefit, the accidental, additional, and spouse death benefits, and the state of issue. See Ryan’085, Figures 6-14. In order to produce an illustration or application, a human (i.e., not a processor) must choose an actual insurance policy. See Figures 13, 16-18. At every interaction with Ryan’s system, the user is continually providing input to the processor throughout Ryan’s process.

The present claims are directed to a continuous method that considers client and financial data, determines whether to offer a product for a specific entity, outputs an offer for the determined product, and then moves on to the next client, all these steps without input from an agent. In Ryan, because a user is specifying all of the parameters, there is no reasonable construction in Ryan that allows one to glean that Ryan’s method uses a processor to determine whether to offer a financial product.

Third, Ryan does not teach the operation whereby “the processor uses client-specific decision information to automatically select parts of variable information from at least two different databases with the client data and the financial product data to determine the variable information specific to each specific entity and select the parts of the variable information determined for inclusion in a specific communication formulated to express an offering for the determined financial product or service or both for the specific entity.” The Examiner states

Applicant argues that Ryan doesn’t teach receiving variable information from at least two different databases. The Examiner disagrees with Applicant because in Ryan, the user personal information can be entered manually or can be obtained from various data table stored in various databases. In Block 140, the system retrieves information regarding the prospective insured(s)’ from various stored tables. Applicant argues that Ryan teaches away from variable information determination. The Examiner disagrees with Applicant because Ryan teaches varying the amount (variable information) on the insurance policy based on the user’ [sic] personal information. Therefore contrary, to Applicant’s arguments, Ryan doesn’t teach away from variable information. Advisory Action (10/31/08), p. 2.

Ryan does not contemplate variable information as it is defined by Applicant’s specification and claims. Varying information is not the same as variable information as claimed. Block 140 gathers information from storage that was manually-entered information. This manually-entered information is **transferred** to an illustration, **unchanged**. In other words, a processor does not **determine** this information nor does it vary the information.

Contrary to the Examiner’s statement, Ryan does not vary anything based on the user’s personal information. Ryan calculates a result based on non-variable information and then publishes this result as an illustration. For example, a look at Fig. 27A reveals that the processor has merely transferred manually-entered information to an illustration that summarizes the information. Obviously, if a user enters different information (e.g., the user decided to enter a higher death benefit or a different age), Ryan calculates a different result and outputs that result. However, if this occurs: (1) the method is now different from the claims because the user is manually changing the product and thus a processor is not making the determination whether to offer a product; (2) a human and not a processor, is varying the amounts of the insurance policy; and (3) an automated process cannot be considered to be composing the variable information because the only way it is varied is through modification by a user.

Additionally, Ryan, in his ‘Abstract’ supports a teaching away from any disclosure of variable information determination. For example, the ‘Abstract’ states “[a] computer accesses a database into which data is written and from which data is read, the data including information regarding the life to be insured, general applicant information, insurance information and **predetermined text data** for incorporation into insurance illustrations.” (emphasis added). Predetermined text data certainly does not constitute variable information as claimed.

Lastly, Ryan does not disclose “using an output module associated with said processor and configured to use at least one automated process to automatically compose said variable information comprising said parts determined to create and generate said communication for each said specific entity such that at least one portion within said communication accommodates said variable information, wherein said variable information for each specific entity comprises at least partially a customized identification, specification and/or promotion of said financial product or said financial service or both wherein said variable information for each specific entity has at least some data that is different.” The Examiner states

With respect to automatically composing the variable information. The Examiner wants to point out that Ryan teaches based on the user’s information automatically displaying customized insurance policy with different amounts and terms based on the user’s information. The display in itself is the output that is automatically displayed to the user based on the user’s data. Advisory Action (10/31/08), p. 2.

Ryan states

[t]urning to Fig. 3B-8 at Block 166, the **values relevant to the computation of an illustration are generated, then displayed at the user’s terminal** in Block 168, and stored in the Database 26. **The user can select a number of options:** Print Illustration? 172, which will print the information on the Local Printer 30 via Block 174; Print and Mail Illustration? 176, which will print the illustration on the Central Printer 20 for mailing to a requested address via Block 178; and Make Application Using This Illustration? 180, which merges illustration results for further analysis or review. (Col. 22, lines 25-36).

Only the **values relevant to the computation** are displayed on the terminal, Ryan does not disclose the step of “automatically displaying customized insurance policy with different amounts and terms based on the user’s information” as the Examiner asserts. By assuming the Examiner’s logic, and by virtue of the above quote, Ryan further teaches away from the present claims because the calculated values are not shown on the display screen. The **only** way Ryan

discloses producing an illustration is for the user to manually choose how the illustration should be printed. This is certainly not an automated process.

Accordingly, Ryan does not, and cannot, anticipate the present claims, as it does not disclose each and every element of the claims as the Applicant has demonstrated here. Although the distinctions between Ryan and the present claims have been described with respect to claim 1, the argument and distinctions are similar with respect to the other pending independent and dependent claims. Therefore, Applicant respectfully requests withdrawal of this rejection for all pending claims.

35 U.S.C. § 103 Rejections

Claims 12-52, 74-115, 132-138, 142, 170 and 180 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan. Applicant respectfully traverses this rejection.

Claims 12-52, 74-115, 132-138, 142, 170 and 180 variously depend from the independent claims discussed above. The Examiner does not cite any other reference for the rejection of claims 12-52, 74-115, 132-138, 142, 170 and 180. Nowhere does Ryan disclose an automatic process for producing high volume offers in an automated manner. In fact, Ryan teaches away from the present claims.

As such, Applicant submits that these claims are patentable over Ryan for at least the reasons discussed under the § 102 section. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Conclusion

All of the stated grounds of rejection have been properly traversed. Applicant therefore respectfully requests the Examiner to reconsider all presently outstanding rejections and to withdraw them. In the event the Examiner does not find the claims here allowable, Applicant requests another interview with the Examiner to understand the Examiner's point of view.

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Respectfully submitted,

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